

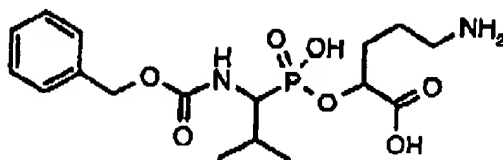
REMARKS

In light of Applicants' election of restriction group I and further election of the single species 5-Amino-2-[(benzyloxycarbonylamino-2-methyl-propyl)-hydroxy-phosphinoyloxy]-pentanoic acid, and pending the identification of subject matter directed to "a generic concept" which would result in reinstatement and examination of additional claimed subject matter, claims 1, 6, 9, 18 and 20, reading on the elected species, are pending in the application.

These claims have been rejected under 35 USC §103(a) as being obvious over U.S. Patent No. 5,550,119 to De Lombaert et al. in combination with U.S. Patent No. 5,801,271 to Seido et al. The Examiner asserts that the De Lombaert patent teaches "phosphorus compounds of the type recited in the claims" and that any deficiencies in this teaching are made up by disclosure in the Seido patent. In particular, the Examiner acknowledges that the De Lombaert patent does not teach "the benzyloxycarbonylamine [sic] substituent," but asserts that the Seido patent makes up for this by teaching "analogous pentonic (?) acid derivatives which contain this group in compounds having the same utility." The Examiner's assessment is in error for the following reasons.

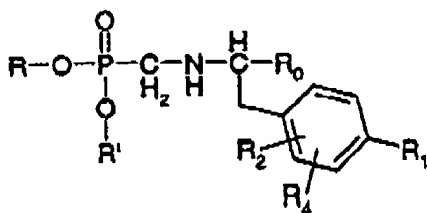
In the first place, the single species elected by Applicants, Example 1 of the present application, has the

chemical structure:



As can be seen from this formula, the compound is a phosphorus-containing compound comprising a central phosphorus which is oxy-linked to a 5-aminopentanoic acid moiety (see right-hand side of figure above) and which phosphorus atom is also directly linked to a benzyloxycarbonylaminoalkyl group (see left-hand side of figure above). For purposes of instruction and argument, the aminopentanoic acid moiety can also be thought of as an alkyl group substituted by both an amino and a carboxyl group.

On the other hand, the De Lombaert compounds particularly cited by the Examiner and claimed in the patent are phosphorus-containing tetrazole derivatives having the generic formula:



Applicants wish to point out to the Examiner that neither R nor R' in the De Lombaert formula, both of which substituents are oxy-linked to the phosphorus, can be an alkyl group carrying both an amino group and a carboxyl group. Furthermore, De Lombaert provides neither encouragement nor even the remotest suggestion to a person of skill in the art to replace either R or R' with such a group.

Thus, not only does the primary reference of De Lombaert not teach the benzyloxycarbonylaminoalkyl group of Example 1 and other instant compounds (again, as acknowledged by the Examiner), but it does not teach the oxy-linked aminocarboxylic acid group of Example 1 and other instant compounds either. Furthermore, the De Lombaert compounds in question are tetrazole derivatives. In other words, the Examiner's assessment that the De Lombaert compounds are "of the type" of the instant compounds is certainly a stretch in terms of the criteria for determining obviousness. In actuality, De Lombaert contributes nothing that could reasonably be combined with Seido to arrive at the compound of instant Example 1.

This leaves the examination with what Seido teaches. Even if the Examiner's assessment of the relevance of the Seido patent were completely accurate, implicit in the Examiner's combination of Seido with De Lombaert is the acknowledgment that Seido cannot stand on its own as a bar to patentability; as

shown above, however, De Lombaert provides nothing of help to Seido.

On top of all this, it should also be pointed out that the Examiner's assertion that the utility of the Seido compounds is the same as that attributed to the De Lombaert compounds is in error. Thus, whether or not the Examiner's assertion that the Seido compounds are "analogous" to other compounds relevant to this patentability analysis is valid, Seido cannot be said to render obvious the instant invention.

As Seido discloses, a benzyloxycarbonyl group can be used as a protecting group for amino functions (see Seido, column 2, line 66 to column 3, line 1) during synthesis of end-products. This further reinforces what would be clear to anyone of skill in the art reading the Seido disclosure, namely, that the Seido compounds disclosed as inventive are intermediates; on this basis alone, the Seido compounds cannot be said to have the same utility as that of the compounds of the primary reference. Furthermore, the Seido intermediate compounds are to be used in the preparation of Ritalin (see column 1, lines 10-20 of Seido), which compound has no similarity of utility to the De Lombaert compounds. Even if the Seido compounds cited by the Examiner were end-products, their alleged analogousness to other compounds considered during prosecution would still be ineffective in light of the utility analysis of the respective

compounds. It might be added for good measure that the instantly claimed utility constitutes yet another utility distinct from that disclosed in either of the references.

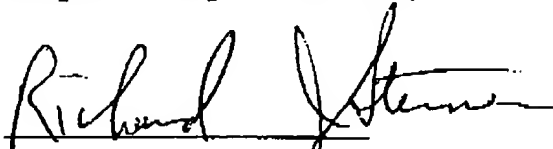
For all of the reasons set forth above, there is no way that the cited references, either alone or in combination, can be said to provide a *prima facie* case of obviousness against the instant invention. In fact, there is really no relevant link at all between the two cited references. It is hereby respectfully requested that the Examiner's stance be reconsidered, the rejection be withdrawn, the search for allowable subject matter be expanded and that, as appropriate, claims not presently being considered be reinstated.

No fee should be due in connection with this communication, since it is being submitted within three months of the date of issue of the outstanding Office Action. However, should it be determined that a fee is required for any reason, the Assistant

Commissioner is hereby authorized to charge it to Deposit
Account No. 23-1703.

Dated: September 17, 2002

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Richard J. Sterner", written over a horizontal line.

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